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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Michael D. Hooven

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COOK ALEX LTD

SUITE 2850

200 WEST ADAMS STREET

CHICAGO, IL 60606

EXAMINER

CHEN, VICTORIA W

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/015,868	Applicant(s) HOOVEN, MICHAEL D.	
	Examiner VICTORIA W. CHEN	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50, 54-58 and 67-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 50, 54-58, 67-76 and 81 is/are rejected.
- 7) ☒ Claim(s) 77-80 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/25/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 57 and 70 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 57 recites “at least one of the conductive members defines an interior lumen” in ll. 1-2. However, there is no mention of the conductive members having an interior lumen in the specification.

Claim 70 recites “each jaw assembly includes two or more jaw support members” in ll. 1-2. However, there is no mention of the possibility of more than one jaw support member in each jaw assembly in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 55 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 55 recites the limitation "said portion" in ln. 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent,

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 76 and 81 are rejected under 35 U.S.C. 102(a) as being anticipated by Parins et al. (US 5908420).

Regarding claim 76, Parins discloses first [60] and second [62] jaw assemblies [Fig. 6], the jaw assemblies being movable between open and closed positions, each jaw assembly having an elongated electrically conductive member [123, 122], the conductive members in face to face relation and connectible to a bipolar energy power source [col. 5, ll. 15-20] so as to be of opposite polarity, each jaw assembly including an internal jaw support member [132, 134, Fig. 6] and an insulative cover [86, 87] that sufficiently surrounds the internal jaw support member to prevent contact of such internal jaw support member with the selected ablation area [Fig. 6].

Regarding claim 81, Parins discloses first [60] and second [62] jaw assemblies [Fig. 6], the jaw assemblies being movable between open and closed positions, each jaw assembly having an elongated electrically conductive member [123, 122], the conductive members in face to face relation and connectible to a bipolar energy power source [col. 5, ll. 15-20] so as to be of opposite polarity, each jaw assembly including an internal jaw support member [132, 134, Fig. 6] and an insulative cover [86, 87] that completely surrounds the internal jaw support member [Fig. 6].

Claims 50, 54, 56-58, 67-69 and 71-75 are rejected under 35 U.S.C. 102(b) as being anticipated by Paraschac (US H1745).

Regarding claim 50, Paraschac discloses an ablation apparatus comprising first [116] and second [117] jaw assemblies [Fig. 5], the jaw assemblies being movable between open and closed positions, each jaw assembly having an elongated electrically conductive member [147, 148], the conductive members in face to face relation and connectible to a bipolar energy power source [col. 7, ll. 5-9] so as to be of opposite polarity, each jaw assembly including an internal jaw support member [123, 124] and an insulative cover [134, 164, 146, 156] that surrounds the internal jaw support member [Fig. 5], wherein the internal jaw support member is insulated relative to and does not contact the conductive member of the respective jaw assembly. The insulative cover is interpreted as surrounding the internal jaw support member when the jaws are in a closed position around the internal jaw support member.

Regarding claim 54, Paraschac discloses each jaw assembly has a clamping surface [inner surfaces of 116 and 117, Fig. 5] having a width, and each conductive member has a tissue contacting portion with a width [widths of elements labeled 119 and 118 in Fig. 5], and wherein each tissue contacting portion's width can be seen to be less than the width of the associated clamping surface.

Regarding claim 56, Paraschac discloses the conductive member is generally centrally located relative to the clamping surface [Fig. 5].

Regarding claim 57, both conductive members define an interior lumen [120, 121].

Regarding claim 58, Paraschac discloses each jaw assembly has a clamping surface [inner surfaces of 116 and 117, Fig. 5] and a portion of the clamping surface is disposed on each side of the conductive member [Fig. 5].

Regarding claim 67, it is inherent that each jaw assembly includes an opening disposed for receiving a respective conductive member therein, since there is a conductive member within each jaw assembly.

Regarding claims 68 and 73, it is inherent that each insulative cover includes an opening disposed for receiving a conductive member therein since each insulative cover [134, 164, 146, 156] surrounds its respective conductive member [147, 148]. The opening can also be interpreted as a groove.

Regarding claim 69, each jaw assembly has a clamping surface [inner surfaces of 116 and 117, Fig. 5] and each insulative cover [134, 164, 146, 156] is located on each side of the respective elongated conductive member [Fig. 5] of the corresponding jaw assembly and forms the clamping surface.

Regarding claim 71, Paraschac discloses each elongated conductive member protrudes through an opening in the respective insulative cover [Fig. 5].

Regarding claim 72, Paraschac discloses each jaw assembly has a clamping surface and each elongated conductive member is substantially flush with the respective clamping surface [Fig. 5, e.g. 118 is flush with 134].

Regarding claim 74, Paraschac discloses each insulative cover insulates the corresponding internal jaw support member from the conductive member [Fig. 5, e.g. insulative cover 146 and 134 of jaw 116 insulates internal jaw support member 123 from conductive member 147].

Regarding claim 75, Paraschac discloses the clamping surface is insulative, since clamping surface [inner surface of 116, Fig. 5] includes insulative parts [146, 134].

Claims 50, 54, 56, 58, 67-70 and 72-75 are rejected under 35 U.S.C. 102(b) as being anticipated by Kamiyama et al. (US 5151102).

Regarding claim 50, Kamiyama discloses first and second jaw assemblies [10, Fig. 2], the jaw assemblies movable between open and closed positions, each jaw assembly having an elongated electrically conductive member [10f] in face to face relation [Fig. 4], connectable to a bipolar energy power source [col. 2, ll. 19-23], each jaw assembly including at least one internal jaw support member [10b, Fig. 4] and including an insulative cover [10a] that surrounds the internal jaw support members, wherein the internal jaw support member is insulated relative to the conductive member [10f] of the respective jaw assembly [Fig. 4].

Regarding claim 54, Kamiyama discloses each jaw assembly has a clamping surface [surface of element 10 in Fig. 4] with a width and each conductive member has a tissue contacting portion with a width [10f] and wherein each tissue contacting portion has a width that is less than the width of the associated clamping surface [Fig. 4].

Regarding claim 56, Kamiyama discloses each conductive member [10f] is located generally central to the associated jaw assembly [Fig. 4].

Regarding claim 58, Kamiyama discloses each jaw assembly has a clamping surface [surface of element 10 in Fig. 4], and a portion of the clamping surface is disposed on each side of the conductive member [10f, Fig. 4].

Regarding claims 67, 68 and 73, it is inherent that there is an opening in the insulative cover [10a] disposed for receiving the respective conductive member [10f]

Art Unit: 3739

within each jaw assembly since the conductive member is seen as being within the insulative cover of each jaw member [Fig. 5]. The opening can also be considered a groove.

Regarding claim 69, Kamiyama discloses each jaw assembly has a clamping surface [surface of element 10 in Fig. 4] and each insulative cover [10a] is located on each side of the respective elongated conductive member of the corresponding jaw assembly and forms the clamping surface [Fig. 4].

Regarding claim 70, Kamiyama discloses at least two internal jaw support members [Fig. 4, 10b] on each jaw.

Regarding claim 72, Kamiyama discloses each jaw assembly has a clamping surface [surface of element 10 in Fig. 4] and each elongated conductive member [10f] is flush with the respective clamping surface [Fig. 5].

Regarding claim 74, Kamiyama discloses the insulative cover [10a] insulates the corresponding internal jaw support member [10b] from the conductive member [10f] [col. 2, ll. 29-34].

Regarding claim 75, the clamping surface [surface of element 10 in Fig. 4] is insulative since it includes the surface of insulative cover [10a].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 55 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paraschac, as applied to claim 50 above.

Regarding claim 55, Paraschac teaches the claimed invention except for the specific length and width of the conductive members. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the length and width of the conductive members since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Allowable Subject Matter

Claims 77-80 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 50, 54-58, 67-69, 71-73 and 75-81 have been considered but are moot in view of the new ground(s) of rejection.

New reference Parins (US 5908420) has been added to address claims 76 and 81 as seen above, and a new interpretation of Paraschac has been applied, also as seen in the above rejections.

Applicant's arguments filed 7/17/08 regarding the 35 USC 103 rejections by Kamiyama have been fully considered but they are not persuasive. With respect to applicant's argument that the insulative cover [10a] fails to surround jaw support member [10b], the examiner submits that there is no claim language which necessitates the complete enclosure of the internal jaw support member by insulative cover, and the

definition of "surround" [to form an enclosure round; encircle¹] is broad enough to encompass the relation between the elements 10a and 10b as disclosed by Kamiyama. With respect to applicant's arguments that internal jaw support members [10b] reduce mechanical strength of the jaw component, the examiner would like to point out that Kamiyama states that only over a certain surface area ratio do the internal jaw support members because to cause lowering of mechanical strength, and the invention of Kamiyama intentionally avoids this in order to prevent loss of mechanical strength [col. 3, ll. 18-34]. Therefore, with the ideal surface area ratio of elements 10b as taught by Kamiyama, the elements are not detrimental and do provide jaw support.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTORIA W. CHEN whose telephone number is (571)272-3356. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

¹ "surround." *Dictionary.com Unabridged (v 1.1)*. Random House, Inc. 10 Oct. 2008.
<Dictionary.com <http://dictionary.reference.com/browse/surround>>.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Peffley/
Primary Examiner, Art Unit 3739

/Victoria W Chen/
Examiner, Art Unit 3739